

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

No claims are currently being canceled.

No claims are currently being amended.

Claims 43 and 44 are currently being added.

This response adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After adding the claims as listed above, claims 25-44 are now pending in this application.

Claim Rejections – Prior Art:

In the Office Action, claims 25-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,671,370 to Heinonen et al. in view of U.S. Patent No. 5,821,874 to Parvulescu and further in view of U.S. Patent No. 6,560,467 to Kim. This rejection is traversed for the reasons given below.

In its rejection of claims 25, 27, 33, 34, 37 and 41, the Office Action asserts that Heinonen teaches a key pad (see Figure 2 and special access key 28) that is operative to provide control signals to a control section to cause the control section to search a call history storing area in the control section and the telephone directory memory and, upon a match resulting from the searching, cause to output one of a plurality of sounds which corresponds to a pre-registered calling party stored in the telephone directory memory (see column 7, lines 19-25). Applicant respectfully disagrees with these assertions made in the Office Action.

Namely, as explained in the previously-filed response, Heinonen describes a system and method that allows a calling party to select a particular ring tone that will ring at a called party. While Heinonen's system also allows a user of a telephone to check missed calls, the user must look at a display on the telephone to see the missed calls and to select one to call

back. This requires that the user of the telephone open up, or unfold, the telephone to see the display. In any event, even if the operator selects one of the missed calls on the missed call list provided on the display, no sound is emitted when this is done. Rather, the missed call party is called, presumably using a standard ring tone that rings at the called party. No sounds are provided by the telephone at the calling party when this occurs.

Turning now to claim 25, that claim recites that operation of a key causes a control section to search an incoming call history storing area in a control section and the telephone directory memory, and upon a match resulting from the searching, cause to output one of a plurality of sounds which corresponds to a pre-registered calling party. While it is true that Heinonen's telephone stores different ring tones for different calling parties, there is no searching of these ring tones when an operator of Heinonen's telephone selects one of the missed calls on the display of Figure 5 of Heinonen. Rather, only when the operator desires to call a particular party does the operator then select a particular ring tone that will ring at the called party. In other words, the Examiner appears to try to awkwardly combine the 'missing call' features of Figure 5 of Heinonen with the 'ring tone selection to a called party' features of Figure 3 of Heinonen, when in reality these are two separate features that are not related to each other. In any event, there is no disclosure or suggestion that the stored ring tones are searched when the operator of Heinonen's telephone seeks to call one of the missed parties shown in the display of Figure 5 of Heinonen.

Thus, since no searching of an incoming call history storing area with a telephone directory memory to check for a match is performed in the system and method of Heinonen, and since no sound corresponding to a calling party is output through operation of the key (note, at best, even if the Examiner is somehow interpreting the sound made at the called party's telephone when the calling party calls him/her as corresponding to the claimed "sound", this sound corresponds to the called party, and not the calling party).

The Office Action relies on Parvulescu et al. to attempt to overcome the above deficiencies of Heinonen. In particular, the Office Action relies on Figure 4 and column 4, lines 20-23 of Parvulescu et al. to allegedly teach a key operative to provide control signals to a control section to cause the control section to search in incoming call history storing area in the control section and a telephone directory memory. Applicant respectfully disagrees.

Parvulescu et al. is directed to a voice notification system for a messaging terminal in which, when a receiver receives a message, the message is matched with a pre-recorded voice

prompt stored in a memory, so that the pre-recorded voice prompt is audibly played when the message is received by the messaging terminal. For example, when a message from one's spouse is received, a voice message can be played at the user's terminal to audibly state "Message Received from Spouse." See column 3, lines 1-27 of Parvulescu et al.

Column 4, lines 20-23 of Parvulescu et al. describes that a keypad or other input device is used to allow for controlling the various functions of the messaging terminal, but this only means that a keypad can be used by a user to perform various functions on the messaging terminal based on receipt of a message (such as to initiate a call back to the party that sent the message to the user, or to turn on/off certain notification features such as the LEDs). It does not teach or suggest that a user can utilize the keypad in order for the user to select a desired voice prompt to be played when a particular message arrives at the user's messaging terminal. In this regard, it appears that the Examiner is reading too much into this portion of Parvulescu et al., whereby this clearly amounts to hindsight reconstruction of the claimed invention, which of course is an improper basis for rejecting the claims.

Note also that the system of Heinonen is directed to things that happen at the calling party's telephone, and thus to combine it with Parvulescu et al., which relates to things that happen at the called party's telephone, makes such a combination tenuous at best. In other words, things that happen at a calling party's telephone regarding when that calling person's telephone is open or is folded shut, is not especially pertinent to things that happen at a called party's telephone regarding when that called person's telephone is open or is folded closed.

Since Kim does not rectify these deficiencies of Heinonen and Parvulescu et al., claims 25, 27, 33, 34, 37 and 41 are patentable over the combination of Heinonen and Kim.

With respect to dependent claims 26 and 36, the Office Action asserts that column 7, lines 19-44 of Heinonen describes a control section that causes to output one of a plurality of sounds corresponding to a second one of the pre-registered calling parties who called prior to a first one of the pre-registered calling parties in response to multiple successive operations of the key. Applicant respectfully disagrees.

While column 9, lines 20-26 of Heinonen describes a display of missed calls that allows a user to select a missed call to thereby make a call to that missed call party, this is done based on the user's selection of which missed call to call, and it does not provide a sound corresponding to the selected missed call party. Again, it appears that the Examiner awkwardly trying to combine the 'select ring tone to ring at called party' features of Figure 3

of Heinonen with the 'make a call to a missed call party' features of Figure 5 of Heinonen, when in fact these are totally separate features that are not combinable with each other. In more detail, assuming that the user of Heinonen's system selects a missed call party from the display in Figure 5 of Heinonen, and then the user desires to call that missed call party by selecting a ring tone from a list of pre-determined ring tones, as described in column 7 of Heinonen, no sounds are provided at the calling party's telephone, and also no predetermined order of sounds based on whose missed call came first to the calling party is made in such a system of Heinonen.

Rather, a user must select which calling party to select, and which ring tone to be provided to that calling party, and furthermore this would not be done in response to multiple successive operations of the key. That is, in the system of Heinonen, if the special access key is successively activated, it is unclear what would happen, and certainly there is no teaching that sounds from a predetermined order of missed call parties would be made.

Accordingly, claims 26 and 36 are patentable for these additional reasons.

New Claims:

New claims 43 and 44 have been added to recite features described on page 15 of the specification, whereby such features provide an additional basis of patentability for those claims.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this response, Applicant believes that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 27, 2006

By Phillip J. Articola

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 945-6014

Facsimile: (202) 672-5399

George C. Beck

Registration No. 38,072

Phillip J. Articola

Registration No. 38,819